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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,359	12/06/2000	John H. Jebens	29544/36981	8464
4743 7590 07/10/2008 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER COLBERT, ELLA	
			ART UNIT 3696	PAPER NUMBER
			MAIL DATE 07/10/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/731,359

**Applicant(s)**

JEBENS ET AL.

**Examiner**

Ella Colbert

**Art Unit**

3696

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 104-112 and 121-126 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 104-112 and 121-126 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

### **DETAILED ACTION**

1. Claim 104-112 and 121-126 are pending. No claims have been amended in the communication filed 3/11/08 entered as Response After Non-Final Action.
2. The affidavits under Rule 131 or 132 filed 07/03/06 and 09/17/03 are acknowledged and have been entered.
3. The rejections from the prior Office Actions are hereby withdrawn in view of the new grounds of rejection.

A restriction has been found after a careful review of the claims in preparation to allow the application as set forth here below.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 104-107, 121, and 125, drawn to a digital image management system with an electronic storage facility for providing storage for high resolution digital images with some of the high resolution digital images stored being used to develop corresponding low resolution copies, each of the high resolution digital images having a higher bandwidth requirement, accessing the high resolution digital images of the first image provider by an authorized user identified by the first image provider, the high resolution digital images of the first image provider are transparent to other unrelated image providers, notifying the authorized user identified by the first image provider that the authorized user has been authorized to download a low resolution copy corresponding to one of the high resolution digital images,

allowing the authorized user to download the low resolution copy, and routing one of the high resolution digital images to a printer, classified in class 345, subclass 132.

- II. Claims 108-110 and 122, drawn to a digital image management and delivery system for providing storage for digital images of a plurality of unrelated image providers, a searching engine for developing a subset of the digital images stored in the storage device of the first image provider, a mail server for e-mailing a notification message to the authorized user, a transmitter for transmitting a portion of a pathname to the first authorized user, a router for electronically routing a high resolution copy of the digital image contained in the subset of digital images, classified in class 709, subclass 209.
- III. Claim 111, 123, and 126, drawn to a method of managing digital images with storing a high resolution and a low resolution copy of the digital image, storing a high resolution and a low resolution copy of a second digital image provided by a second image provider in a searchable format, permitting the first image provider to locate and download the low resolution copy of the digital image, the second digital image provided by the second image provider being transparent to the first image provider, e-mailing a notification message to a first authorized user, transmitting a portion of the pathname associated with the digital image, receiving instructions from the first authorized user directing the digital image be

printed, and routing automatically the high resolution copy of the digital image to a printer, classified in class 707, subclass 3.

- IV. Claim 112 and 124. drawn to a digital image management and delivery system with a storage device for storing digital images received from a first digital image provider and a second image provider, a searching engine for developing a subset of digital images stored in the storage device in response to inputs received from a first user, a job order developer responsive to inputs received from the first user for developing a job order, a router for routing the job order developed by the job order developer to a printer, a user identifier for discriminating between users communicating with the system to control user access to the digital images stored in the storage device, a mail database for e-mailing a notification message to the one user identified by the first digital image provider, a transmitter for transmitting a portion of the pathname to the user identified by the first digital image provider, and a router for electronically routing one or the low resolution copies to the at least one user identified by the first digital image provider, classified in class 715, subclass 530.

Inventions I and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a materially different product or (2) that the product

as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case Invention I, the apparatus (System) can be used for providing storage for any documents or information and Invention III, the method can be used for managing the digital images or managing documents by retrieving them from storage.

Inventions II and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention II has a digital image management and delivery system for providing storage for digital images of a plurality of unrelated image providers, a searching engine for developing a subset of the digital images stored in the storage device of the first image provider, a mail server for e-mailing a notification message to the authorized user, a transmitter for transmitting a portion of a pathname to the first authorized user, a router for electronically routing a high resolution copy of the digital image contained in the subset of digital images and Invention IV has a digital image management and delivery system with a storage device for storing digital images received from a first digital image provider and a second image provider, a searching engine for developing a subset of digital images stored in the storage device in response to inputs received from a first user, a job order developer responsive to inputs received from the first user for developing a job order, a router for routing the job order developed by the job order developer to a printer, a user identifier

for discriminating between users communicating with the system to control user access to the digital images stored in the storage device, a mail database for e-mailing a notification message to the one user identified by the first digital image provider, a transmitter for transmitting a portion of the pathname to the user identified by the first digital image provider, and a router for electronically routing one or the low resolution copies to the at least one user identified by the first digital image provider. The subcombination has separate utility such as Invention II can be used for searching for a subset of digital images or data and e-mailing a user a message and Invention IV has separate utility such as storing the digital images received from a first digital image provider, a job order developer for responding to inputs from a user for developing the job order, and routing the job order developed by the job order developer to a printer.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above

and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement



will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

July 2, 2008

**Application Number**

Application/Control No.

09/731,359

Applicant(s)/Patent under  
Reexamination

JEBENS ET AL.

Examiner

Ella Colbert

Art Unit

3696